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# Supreme Court of the United States

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October Term, 1948

No. 582

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HAZELTINE RESEARCH, INC.,  
*Petitioner,*

*vs.*

GENERAL MOTORS CORPORATION,  
*Respondent.*

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## REPLY BRIEF FOR PETITIONER.

Respondent, having fortuitously won below on the erroneous refusal of the Court of Appeals to accept a pivotal finding of fact by the District Court, now seeks to avoid review by this Court on the pretense that the decision of the Court of Appeals hinged merely on "a question of law" (Respondent's Brief, p. 8), apparently *in vacuo*. Certainly the District Court found, as a fact, *a continuity of disclosure* of the subject matter in issue between the patent here involved and its antecedent parent application. Certainly the Court of Appeals predicated its own decision *on a rejection of that finding and on an unwarranted substitution of its own finding of variance of disclosure*.

Petitioner seeks certiorari to correct the error of the Court of Appeals in erroneously setting aside the District Court's finding of fact *as a prerequisite* to its own decision on "a point of law".

The Brief for Respondent contains a number of statements which it is believed are inaccurate or misleading and require comment and these will be considered in the order of their appearance in Respondent's Brief.

### **I. Statement of Facts.**

1. Respondent suggests (Brief, p. 3) that Petitioner implied that the descriptions of the figures added to the patent in suit were found in the original application. No such statement or implication is found in the Petition. It is Petitioner's position that the descriptions of the figures common to the original application (Figs. 1 and 4) and the patent in suit (Figs. 1 and 2) are also substantially common. These are the figures essential to this controversy.\*

2. Respondent (Brief, pp. 4, 5) points to the lack of the term "peak detector" in the original application. This term was merely a convenient short title admittedly coined at a later date to identify the detector completely illustrated and described in both the original application and the patent in suit. This type of detector was defined in the "Glossary of Terms" (R. 1689) cited with approval by Respondent (Brief, p. 5). *Every element* of this apparatus *defined by the claims in suit* is fully disclosed in the *original application*, even to the sizes and values of the circuit elements. In the plate opposite R. 1756, typical claims in suit are applied in detail to the disclosures of both the original application and the patent in suit, with reference to Attachments 1, 2, and 3 (R. 1764A, 1764B, and 1764C).

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\* Of the figures added to the patent in suit, Figs. 3, 4, and 6 are solely explanatory in nature and *not essential* to the disclosure of the claimed invention; Figs. 5, 7, 8, 9, and 10a-10h, inclusive, illustrate other modified forms of the invention none of which is essential to the disclosure of the claimed invention.

3. Respondent inadvertently agrees with the foregoing statement of facts when it says:

“ \* \* \* ‘Peak detection’ involves the use of the same elements as are shown in the original application, but requires in addition that there shall be applied to the *diode* (the two-electrode tube common to the circuits of both applications) a sufficiently high (i. e. strong) signal. When that is done, *the peak detection effect is inevitably obtained*, \* \* \* ” (Emphasis Respondent’s; Brief, p. 5).

However, Respondent is in error in implying that the original application did not teach supplying a strong signal to the detector. The original application states that there are advantages attending the application to the detector of a signal voltage “*when this voltage is large*” and that the associated control circuits require a “*large operating voltage, say ten volts*,” which is proportional to the voltage applied to the detector (R. 1397).

Thus, Respondent effectively admits that the peak detector defined by the claims in suit is “inevitably” fully disclosed in the original application.

## II. Argument.

### 1. Respondent states

“ \* \* \* it is quite true that the drawings of the original 1927 application, show parts which, when properly arranged and operated, gave rise to peak detection; *but peak detection as such was not described* as a part of that application \* \* \* ” (Emphasis added; Brief, p. 8).

and elaborates (pp. 8-10) on this theme that the magic words “peak detection” are not found in the original application. This is but a skillful exercise in semantics. It is immaterial that a convenient short title was later coined for Wheeler’s

radically new peak detector; what is *important* is that the *elements of the apparatus claimed* in the patent in suit *were disclosed* in the original application; then, as admitted in the foregoing quotation from Respondent's Brief, "the peak detection effect is inevitably obtained". It is a new example of the old adage that a rose by any other name smells as sweet.

Insofar as the material added to the patent in suit represents an enlarged theoretical explanation of the invention (Figs. 3 and 4; specification page 1 and page 3, line 142 to page 5, line 45; R. 889, 893, 895-897), such an enlargement is authorized by a long line of unquestioned authorities. As was said by the Court of Appeals for the Sixth Circuit in *Michigan Carton Co. v. Sutherland Paper Co.*, 29 F. (2d) 179, 184:

"The rule is that insertions by way of amendment in the description or drawing, or both, of a patent application (fol. 1764) do not invalidate the patent, if they are only in amplification and explanation of what was already reasonably indicated to be within the invention; and this rule applies with special force where the insertion was required by the Patent Office. *General Electric Co. v. Cooper, etc., Co.* (C. C. A. 6), 249 F. 61, 64, certiorari denied 246 U. S. 668, \* \* \*. *And if an inventor comes to better understand the principles of his invention while his application for patent is pending, an amendment of his claim to conform thereto does not introduce any original matter nor enlarge his invention, and is within his legal rights.*" (Citing cases; emphasis added.)

On this point, see the Petition for Rehearing (R. 1757-1759).

2. Respondent cites (Brief, p. 10) *Muncie Gear Works v. Outboard Company*, 315 U. S. 759 for the proposition that the Court of Appeals was right. That case is irrelevant to the facts of this Petition since, as appears from the very

quotations in Respondent's Brief, the decision was based solely on the fact that the description of the patent in suit was substantially changed after its filing to describe an anti-cavitation plate and *the novel feature of the claims in that suit was predicated entirely on the added description*. Originally, neither the specification *nor the drawing* showed the later-claimed construction. In the present case there is no question but that the claims in suit are bottomed squarely on the unchanged original drawings *and specification* carried over into the patent in suit.

3. In its discussion of the decision of the District Court (Brief, pp. 11-12) Respondent makes several misleading statements. It would have this Court believe that the District Court's conclusion that the Petitioner "had made out a pretty good case here" (R. 880) was a tentative preliminary remark. It further states that the District Court, immediately preceding such statement, said that Petitioner had "a pretty tough row to hoe". The facts are that the District Court's statement that Petitioner "had made out a pretty good case here" was made *after* the conclusion of a three weeks' trial; *after* a thorough consideration of exhaustive briefs; and *after* a full day's final argument of counsel. The comment of the District Court on Petitioner's burden of proof, on the other hand, was made *four months prior to*, not immediately preceding, the Court's remark quoted by Petitioner and *before* consideration of any of the briefs and *before* the final argument of the case.

Petitioner has not made any attack on the District Court nor has it attempted to estop the District Court as to its disposition of the case, as suggested by Respondent (Brief, pp. 12, 13). Petitioner has merely pointed out that it is clear that the District Court was overawed by the decision of this Court in *Detrola v. Hazeltine*, 313 U. S. 259 and

erroneously considered itself bound thereby to find against Petitioner in spite of its own independent judgment to the contrary, as evidenced by its statement that Petitioner "had made out a pretty good case here".

Respectfully submitted,

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